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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,048	03/02/2000	Robert Barritz	P/1318-73	5346

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NEW YORK, NY 100368403

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/518,048

Applicant(s)

BARRITZ ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 30-33, 44 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 34-43, and 46-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-29, 34-43, and 46-57 have been examined.
2. Applicant's attorney initiated an informal phone interview with the examiner with respect to the Election Requirement (see Paper No. 6) on 9 January 2004. During the interview, applicant's attorney was informed that, in the Requirement, claim 28 had been erroneously omitted from the list of generic claims.

### ***Response to Arguments***

3. Applicant's election with traverse of the three Election Requirements in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the grounds for the election requirement are not clearly understandable, and that some of the claims being subject to election are related to generic claims.

Regarding the election requirement for claims 29-33 (hereinafter the "first requirement"), Applicant's arguments filed 14 January 2004 have been fully considered but they are not persuasive. Each of the claims teaches to a composition of a different query with respect to the databases. The fact that a claimed database contains certain data fields does not necessarily imply that one skilled in the art would see the advantage in relating various fields to one another, or in testing a field for a particular value. Each of the claims therefore embodies a patentably distinct invention.

Regarding the election requirement for claims 11, 49-51, and 53-55 (hereinafter the "second requirement"), Applicant's arguments, see Paper No. 7, filed 14 January 2004, have been fully considered and are persuasive. The second requirement has been withdrawn. The design choices enumerated for the claimed frequencies with which a database should be updated are well-known in the art and thus do not incur an undue burden with respect to the prior art search.

Regarding the election requirement for claims 43-45 (hereinafter the "third requirement"), Applicant's arguments filed 14 January 2004 have been fully considered but they are not persuasive. The composition of a database does not imply the method for retrieving new data for adding to that database. Each of the groups therefore embodies a patentably distinct invention.

The first and third requirements are still deemed proper and are therefore made FINAL.

#### ***Election/Restrictions***

4. In response to a set of three Election Requirements, applicant has elected Group A from the first requirement and Group A from the third requirement. Due to the withdrawal of the second requirement (see above), the election from that requirement is moot. Claims 30-33, 44, and 45 are therefore withdrawn from examination without prejudice.

***Priority***

5. The instant application claims priority to U.S. Provisional Patent Application No. 60/123,531, filed 5 March 1999.

***Information Disclosure Statement***

6. The following Information Disclosure Statements in the instant application have been fully considered:

Paper No. 2, filed 2 March 2000.

Paper No. 4, filed 7 August 2000.

***Drawings***

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign not mentioned in the description: "12" in figure 1. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(I) as having lines that are not uniformly thick and well-defined. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-29, 34-43, and 46-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Though the invention teaches to the processing of information pertaining to computers, no limitations teach to the claimed knowledge base facility of claim 1 or the software facilities of claims 14 and 34 being necessarily computerized or tangibly embodied on computer-readable media; therefore, the facilities are programs per se.

All other claims depend from rejected claims 1, 14, and 34, and include all the limitations of those claims, thereby rendering those dependent claims non-statutory.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "is representative of" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "is representative of"), thereby rendering the scope of the claim unascertainable. For purposes of the prior art search, it is being presumed that the software agreement database contains at least one field that is directly related to software usage outside of the computer being monitored.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-8, 10, 12, 14-25, 27, 28, 34-41, 48, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,105,069 to Franklin et al. (hereinafter "Franklin")

As per claim 1, 10, 14, 34, the Licensing Controller disclosed by Franklin organizes databases into objects, such as for users, resources (such as computers), and software licenses (see column 4, line 17 to column 5, line 50). A linking between resource and license objects is also described (see column 10, lines 50-60). Franklin also includes a query tool (see column 4, line 66 to column 5, line 21) for using the various databases that outputs query results.

Regarding claims 2, 3, 35, 36, it is disclosed that the system may be run on a single system (see column 4, line 6) or a network of computers. Any package that can be run on a single system inherently can be used on a mainframe.

As per claims 4-6, 37-39, a "numbers" attribute tracks installations, while the "metering" attribute may track actual usage (see column 11, lines 33-57).

As per claims 7, 40, 41, licensing attributes may include multiple contract terms, such as the charges (see column 6, lines 28-40).

As per claim 8, the "terms" includes data for determining the number of installations (see column 11, lines 34-40).



As per claim 12, the linking data is implemented for a many-to-many relationship.

As per claims 15-21, 24, the "methods" fields permit automatic execution.

Regarding claim 22, modern computers are inherently able to do such correlations as least ten times faster than can be done by manual process.

Regarding claim 23, 48, Franklin is inherently capable of correlating up to 100% of the data.

As per claim 25, Franklin discloses the direct creation and modification of the resource databases.

Regarding claim 27, all products in the software license object may be correlated when reviewing licenses, regardless of the state of the resource database.

As per claim 28, all databases contain user-configurable attributes.

As per claim 56, Franklin discloses that the directory services system is highly distributed among nodes; therefore, any database may be on any computer in the network (see column 4, lines 45-51).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al.

Regarding claim 9, Franklin does not disclose the inclusion of the entire text of an agreement in the database.

Official notice is given that the method of including official documents, such as contracts, in databases relevant to those contracts, in order to provide users an easy, unquestionable reference, is well-known in the art.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by including the entire text of an agreement in the linking file, as is well-known in the art, in order to provide users an easy, unquestionable reference.

Regarding claim 29, though Franklin discloses a metering attribute for determining usage levels over a time period, it is not specifically disclosed that correlations be made based upon the value of the metering attribute (see column 11, line 58 to column 12, line 4).

Official notice is given that it is well-known in the art that the efficiency of usage of a commodity can be determined by testing the value of its metering attribute.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by testing the value of the metering attribute, as is well-known in the art, in order to determine the efficiency of software usage.

12. Claims 11, 13, 26, 46, 47, 50-52, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claims 1, 15, and 34, above, and further in view of U.S. Patent No. 6,049,799 to Mangat et al.

Regarding claims 11, 50-52, 54, and 55, the “backlink” attribute disclosed by Franklin provides the means for the immediate updating of linking information when information in the corresponding tables are changed (see column 12, lines 13-27); however, no disclosure is given as to when the updating should actually take place.

Mangat discloses the updating of linking information upon the updating of the corresponding application (see column 11, lines 3-10), and suggests that this is to establish and re-make links (see column 2, lines 9-13).

Regarding claims 13, 26, 46, and 47, though Franklin discloses the use of different distinguished names to identify objects (see column 5, lines 22-30), a method for correlating objects based upon their distinguished names is not disclosed.

Mangat discloses the use of fuzzy logic to associate different documents with similar distinguished names (see abstract).

Mangat further suggests that this all is to establish and re-make links (see column 2, lines 9-13).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating of linking information upon the updating of the corresponding applications, and by using fuzzy logic to

associate databases by their distinguished names, as disclosed by Mangat, in order to establish and re-make links.

13. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 5,867,714 to Todd et al.

Though Franklin discloses a means for incorporating new software product data into the database, the way in which software products are acquired is not disclosed (see column 15, lines 3-17).

The software distribution system disclosed by Todd distributes software from a remote server to computers (see abstract), and suggests that this allows for the remedying of faults before they actually become faults (see column 3, lines 1-8).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by distributing software from a remote server to computers on a periodic basis, as disclosed by Todd, in order to remedy problems before they actually become faults.

14. Claims 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. in view of U.S. Patent No. 6,049,799 to Mangat et al. as applied to claim 52 above, and further in view of Elmasri et al., "Fundamentals of Database Design," 1989, pp. 544-545.

Franklin and Mangat do not disclose the updating of databases on a periodic basis.

Elmasri discloses the updating (committing) of databases periodically at checkpoints, and suggests that this aids recovery in the event of a system crash.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to update the databases using checkpoints, in order to aid recovery in the event of a system crash.

15. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 56 above, and further in view of U.S. Patent No. 5,930,764 to Melchione et al.

Franklin does not disclose any collecting of industry-wide information for consideration.

Mechione discloses the collecting of industry-wide information at a central database for distribution (see abstract), and suggests that this allows individual salespersons to maximize customer satisfaction (see column 5, lines 26-28).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use industry-wide information at a central database, in order for individual salespersons to maximize customer satisfaction.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-29, 34-43, and 46-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 22 of copending Application No. 09/732,386 (hereinafter the '386 application) in view of U.S. Patent No. 6,105,069 to Franklin et al. further in view of U.S. Patent No. 6,049,799 to Mangat et al. further in view of U.S. Patent No. 5,867,714 to Todd et al. further in view of Elmasri et al., "Fundamentals of Database Design," 1989, pp. 544-545 further in view of U.S. Patent No. 5,930,764 to Melchione et al.

The '386 application discloses the cross-referencing of software licenses to software products on a computer, but does not disclose a mechanism for performing the correlation.

Franklin discloses the three independent databases, as described above, and further suggests a need for a convenience for users and administrators for providing

quickly, simply, reliably, and easily the desired licensing services and maintenance abilities over a distributed network.

Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the claimed invention of the '386 application by using the system disclosed by Franklin, for a convenience for users and administrators for providing quickly, simply, reliably, and easily the desired licensing services and maintenance abilities over a distributed network.

All other claims are obvious in view of the other references, as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 4:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Art Unit: 2134

**Or faxed to:**

(703) 872-9306

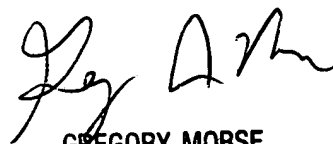
Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MEH



February 24, 2004



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
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